

REMARKS

Claims 23-36 are now pending and stand rejected. Applicant is submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment. By this Preliminary Amendment, Applicant has amended the claims and demonstrates reasons why the claims pending here are distinct from the asserted art. In particular, claims 23, 31, and 36 are amended and claim 26 is canceled, without prejudice. In view of the amendments and the arguments below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

35 U.S.C. § 112 Rejections

In paragraph 2 of the office action, the Examiner maintains the rejections of claims 23-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 recites the limitation “the portable computer” in line 4. There is insufficient antecedent basis for this limitation in the claim. Applicants have amended claim 23 to recite “a portable computer” in the preamble of claim 23, which provides antecedent basis for the later recitation of “the portable computer” in line 4 of that claim. The Examiner is respectfully requested to withdraw the 112 rejection of claims 23-30.

35 U.S.C. § 103 Rejections

Governing Criteria

Firstly, for rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. *MPEP § 2143.03* The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. *MPEP § 2143.03*

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Further, Applicants respectfully submit that obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicant respectfully requests the Examiner reconsider the rejections based on the legal reasoning and case law cited here as well as the amendments to the independent claims.

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Hitani in view of Armstrong

In paragraph 5 of the office action, the Examiner rejects claims 23-30 under 35 U.S.C. §103(a) as being unpatentable over Hitani et al. (U.S. Patent No. 5,900,875), in view of Armstrong et al. (U.S. Patent No. 6,304,170).

Regarding claim 23, the Examiner indicates that Haitani discloses “a method of controlling routing of telephone calls and communications” and points to column 1, lines 6-10, in support of this statement. At column 1, lines 6-10, Haitani simply indicates the “FIELD OF THE INVENTION” as follows:

The present invention relates to the field of portable computer systems. Specifically, the present invention discloses a portable computer system that can quickly be turned on and access relevant information with a minimal user interaction.

There is no disclosure of routing of telephone calls and communications in the section pointed to by the Examiner.

Further, the Examiner points to column 3, lines 12-18, for disclosure of “providing a date book as part of a personal information manager application operating on the portable computer” and column 4, lines 26-30 for a disclosure of “receiving, on said portable computer, an acceptance of said date book alarm..”

When the portable computer system 100 is powered-off, the application function buttons 121, 123, 125 and 127 turn on the portable computer system and then begin executing the associated application. For example, if the user presses the addressbook application button 123, the portable computer system will turn on and begin executing the address book application.

Column 3, lines 12-18

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An easier method of switching between the different multifunction categories exists. Specifically, the user can select between the various multifunction categories in the addressbook by continuing to press the addressbook application button after the addressbook application is executing.

Column 4, lines 26-30

Again, there is no specific indication of a “date book” nor “receiving ...an acceptance of said date book alarm.” An address book is not a date book. Moreover, in column 3, line 53-65 and column 4, lines 26-44, there is no disclosure of “a profile that routes incoming telephone calls to one or more telephone numbers associated with the user.” Haitani, while disclosing applications such as addressbook, calendar, and a To-Do list applications, does not disclose any application relating to routing of calls, much less in the manner claimed.

The Examiner relies on Armstrong et al. for a disclosure of “outputting, on the portable computer, a date book alarm with an audible alert from the date book to alert a user of a particular appointment” and points to column 5, lines 19-35, for that disclosure. Again, Armstrong et al., do not disclose this in the context of the claimed invention. The limitations of claim 26 are included in claim 1, which makes it distinct from the combination of Haitani with Armstrong et al.. Claims 24, 25, 27-30 depend on claim 23 and are distinct at least for the same reasons by which claim 23 is distinct. Specifically, with respect to claim 30, the Examiner points out that Haitani discloses a method, wherein one or more of the plurality of routing profiles further comprises a source phone number (column 4, lines 26-44). Applicant respectfully submits that there is no indication of a “source number” at the section pointed to by the Examiner.

The Examiner is respectfully requested to reconsider the rejections and to allow the claims, as they presently stand.

Haitani in view of Schellinger et al.

In paragraph 6 of the office action, the Examiner has variously rejected claims 31-35 under 35 U.S.C. §103(a) as being unpatentable over Hitani et al. (U.S. Patent No. 5,900,875), in view of Schellinger et al. (U.S. Patent No. 6,052,592).

The Examiner takes the position that Haitani fails to disclose outputting, on said portable computer, said established routing and information on a telephone server and relies on yet another reference, Schellinger et al. to satisfy that aspect of the claimed invention. Haitani is distinct not only for the reasons indicated by the Examiner here but pointed to by Applicant above. Schellinger et al. is directed to a call routing system for a wireless data device and discloses the following at the location pointed to by the Examiner:

The PCC 101 further has the capability to communicate with and place radiotelephone calls via a cordless base station 115, which provides private telephone line interconnection to the TELCO 111 for the user of the PCC 101. The cordless communication system uses an authorization and call routing equipment (ACRE) 117 to provide call routing information to a telephone switching system.

Column 2, lines 58-66

There is no teaching or disclosure in either of Haitani or Schellinger et al. of the claimed feature of “outputting, on said portable computer, a data entry form to permit said user to establish a routing profile for said new appointment, wherein said routing profile defines one or more rules for routing incoming telephone calls to one or more telephone numbers associated with a user of said portable computer between a starting time and an ending time.”

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Claim 33 is distinct at least for this reason. Claims 34-35 depend on claim 33 and are distinct at least for the same reason.

The Examiner is respectfully requested to reconsider this rejection.

Haitani in view of Armstrong and further in view of Schellinger et al.

In paragraph 7 of the office action, the Examiner has variously rejected claim 36 under 35 U.S.C. §103(a) as being unpatentable over Haitani et al. (U.S. Patent No. 5,900,875), in view of Armstrong et al. (U.S. Patent No. 6,304,170), and further in view of Schellinger et al. (U.S. Patent No. 6,052,592). The Examiner takes the position that regarding claim 36, Haitani discloses a method of controlling communication routing (column 1, lines 6-10) and points to text in Haitani that satisfies the claimed steps. Applicant respectfully submits that the claimed steps are not disclosed in Haitani. Therefore, a combination with Armstrong and Schellinger et al. do not satisfy the claimed recitations of claim 36. A combination of the references does not disclose "outputting, on said palmtop computer, an indication of a user selection of a routing profile and information relating to said particular appointment to a telephone server for control of incoming calls to said user during said particular appointment."

The Examiner is respectfully requested to reconsider the rejection.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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